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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,603	06/11/2001	Peter A. Ward	UM-06340	4222

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EXAMINER

VANDERVEGT, FRANCOIS P

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,603

Applicant(s)

WARD ET AL.

Examiner

F. Pierre VanderVegt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) 16-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12 and 15 is/are rejected.
- 7) ☒ Claim(s) 1,2,13 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This application is a continuation of U.S. Application Serial Number 09/387,671.

Claims 3-11 have been canceled.

Claims 12-19 have been added.

Claims 1, 2 and 12-19 are currently pending.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 12, 2004 has been entered.

Election/Restrictions

2. Amended claims 1-2 and newly submitted claims 12-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: in response to the Restriction Requirement mailed September 10, 2002, Applicant elected the invention of Group I, claims 1 & 2, drawn to "a composition comprising a peptide defined by SEQ ID NO: 14 or 15 and portions thereof," **without traverse** in the paper filed November 15, 2002. Amended claims 1-2 and newly submitted claims 12-15 comprise embodiments that are not encompassed within the scope of the elected invention. Claims drawn to 'portions' of at least 5 amino acid residues of SEQ ID NOs: 4, 5 and 16 read upon peptide sequences which are not 'portions' of the elected SEQ ID NOs: 14 and 15.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, **claims 1, 2 and 12-15 are only being examined to the extent that they read upon SEQ ID NO: 14 and 15 and portions thereof.** See 37 CFR 1.142(b) and MPEP § 821.03.

3. Newly submitted claims 16-19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

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Claims 16-19 are drawn to compositions comprising variant C-terminal truncated C5a peptide sequences which are not encompassed by the elected C5a peptide sequences SEQ ID NOs: 14 and 15 or portions thereof.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, **claims 16-19 are withdrawn from consideration** as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant incorrectly labeled claims 3-11 as being "Withdrawn" in the Listing of Claims filed January 12, 2004. Applicant is reminded that claims 3-11 were canceled in the amendment filed November 15, 2002 and the filing of an RCE does not restore canceled claims.

Accordingly, **claims 1, 2 and 12-15, to the extent that they read upon SEQ ID NO: 14 and 15 and portions thereof, are the subject of examination** in the present Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgan et al (J. Immunol. [1992] 148(12):3937-3942; U on form PTO-892).

Morgan teaches a 9 amino acid C5a peptide that has been truncated to exclude the 10 C-terminal amino acid residues. The peptide consists of amino acid residues 56-64 of the C5a peptide (Table 1 in particular). Morgan teaches exposing cells to the peptide in MEM medium which, as a composition comprised buffered saline. It is noted that Morgan is silent as to whether the peptide is capable of reducing C5a binding to neutrophils, however Morgan teaches that the portion of C5a that is responsible for stimulating IL-6 release, and presumably for the activation of neutrophils, is the C-terminal 5 amino acid stretch of residues 70-74, which have been truncated (Abstract in particular). The office does not have the facilities and resources to provide the factual evidence needed in order to establish which C5a fragments are capable of inhibiting C5a binding to neutrophils or that there is a difference between the materials, i.e., that the claims are directed to new materials and that such a difference would have been

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considered unexpected by one of ordinary skill in the art, that is, the claimed subject matter, if new, is unobvious. In the absence of evidence to the contrary, the burden is on the Applicant to prove that the claimed materials are different from those taught by the prior art and to establish patentable differences. See *In re Best* 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte Gray* 10 USPQ 2d 1922 (PTO Bd. Pat. App. & Int. 1989). The prior art teaching anticipates the claimed invention.

Allowable Subject Matter

5. Claims 1, 2 and 13-14 are objected to as being allowable except for the presence in the claims of an invention non-elected **without traverse** in the Paper filed November 15, 2002. Applicant elected the peptides of SEQ ID NO: 14 and 15 and portions thereof without traverse. Accordingly, the recitation of SEQ ID NO: 4, 5 and 16, as well as other fragments of C5a read upon non-elected inventions and must be canceled. Applicant is given the normal amount of time to reply to this Office Action to cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue.


Claims 13-14 are additionally objected to as being dependent upon a rejected base claim.

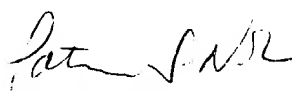
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Pierre VanderVegt whose telephone number is (571) 272-0852. The examiner can normally be reached on M-Th 6:30-4:00; Alternate Fridays 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

F. Pierre VanderVegt, Ph.D. 
Patent Examiner
April 5, 2004


PATRICK J. NOLAN, PH.D.
PRIMARY EXAMINER
4/5/04